



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,013	09/30/2005	Andreas Renz	13478-00002-US	6294

23416	7590	10/05/2007
CONNOLLY BOVE LODGE & HUTZ, LLP		
P O BOX 2207		
WILMINGTON, DE 19899		

EXAMINER	
MCELWAIN, ELIZABETH F	

ART UNIT	PAPER NUMBER
1638	

MAIL DATE	DELIVERY MODE
10/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,013	Applicant(s) RENZ ET AL.	
	Examiner Anne Marie Grunberg	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups I-XVII, claim(s) 1-10, drawn to a process for the production of polyunsaturated fatty acids in an organism comprising a step of introducing a nucleic acid into the organism, wherein the nucleic acid comprises a specified nucleotide sequence or wherein the nucleic acid encodes a polypeptide with at least 40% homology to a specified amino acid sequence; wherein the specified nucleotide sequence for groups I-XVII is SEQ ID NO:1, 3 or 4, 6 or 7, 9, 11, 13 or 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 36, respectively; and the specified amino acid sequence for groups I-XVII is SEQ ID NO: 2, 5, 8, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35, and 37, respectively. Claims directed to a non-elected sequence will be withdrawn from consideration.

Groups XVIII-XXXIV, claim(s) 11-15, 17-23, 27, and 28, drawn to an isolated nucleic acid which comprises a specified nucleotide sequence or wherein the nucleic acid encodes a

Art Unit: 1661

polypeptide with at least 40% homology to a specified amino acid sequence; and to constructs, vectors, and non-human organism comprises said nucleic acid; wherein the specified nucleotide sequence for groups XVIII-XXXIV is SEQ ID NO:1, 3 or 4, 6 or 7, 9, 11, 13 or 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 36, respectively; and the specified amino acid sequence for groups XVIII-XXXIV is SEQ ID NO: 2, 5, 8, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35, and 37, respectively. Claims directed to a non-elected sequence will be withdrawn from consideration.

Groups XXXV-XLIII, claim(s) 16, drawn to an amino acid sequence which is encoded by an isolated nucleic acid sequence that comprises a specified nucleotide sequence or wherein the nucleic acid encodes a polypeptide with at least 40% homology to a specified amino acid sequence; and to constructs, vectors, and non-human organism comprises said nucleic acid; wherein the specified nucleotide sequence for groups XXXV-XLIII is SEQ ID NO:1, 3 or 4, 6 or 7, 9, 11, 13 or 14, 16, 18, 20, respectively; and the specified amino acid sequence for groups XXXV-XLIII is SEQ ID NO: 2, 5, 8, 10, 12, 15, 17, 19, 21, respectively.

Group XLIV, claim(s) 24 and 25, drawn to an oil, a lipid, or a fatty acid and a composition comprising said oil, lipid, or fatty acid.

Group XLV, claim(s) 26, drawn to the use of oil lipids or fatty acids in feed, foodstuffs, cosmetics, or pharmaceuticals.

Art Unit: 1661

Group XLVI, claim(s) 29, drawn to a method of making feed, foodstuffs, cosmetics, or pharmaceuticals utilizing polyunsaturated fatty acids.

Group XLVII, claim(s) 30, drawn to a method of making feed, foodstuffs, cosmetics or pharmaceuticals utilizing oil, lipid, or fatty acid compositions.

2. The inventions listed as Groups I-XLVII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-XLVII is a nucleic acid encoding an enzyme involved in fatty acid metabolism. Lassner et al. teach plant acyltransferases that are involved in fatty acid metabolism (WO 00/18889, see entire document). Therefore, the technical feature linking the inventions of groups I-XLVII does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art.

Accordingly, Groups I-XLVII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected

Art Unit: 1661

process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically

Art Unit: 1661

point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth McElwain whose telephone number is 571-272-0802. The examiner can normally be reached on Monday - Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

Art Unit: 1661

obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Anne Marie Grunberg', with a stylized flourish at the end.

ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER